

## REMARKS

1. In response to paragraph 1 of the Office Action, Applicant acknowledges Examiner's consideration of the references on Applicant's IDS.
2. In response to paragraph 2 of the Office Action, Examiner Jean-Gilles confirmed via telephone on May 11, 2007 that this is a typo and should be ignored. Accordingly, Applicant requests withdraw of this accidental objection by Examiner.
3. In response to paragraph 3 of the Office Action, Applicant acknowledges the Examiner's citation to 35 U.S.C. § 102 (e).
4. In response to paragraph 4 of the Office Action, Applicant acknowledges the Examiner's citation to Godfrey *et al.* (Godfrey), Patent No. 6,941,349 B2 as forming the basis for the Office Action's rejection of Applicant's claims 1-20 under 35 U.S.C. § 102 (e). Applicant objects with traverse to Godfrey anticipating Applicant's claims 1-20.

For a claim to be anticipated, Godfrey must describe each element and limitation of that claim.<sup>1</sup> Further, Godfrey "must also enable one of skill in the art to make and use the claimed invention."<sup>2</sup> Below, Applicant shows that none of Applicant's claims are anticipated by Godfrey as a matter of law.

The Office Action solely points to Figures 12 and 13 and column 5, lines 33-60 of Godfrey to hold that each of Applicant's independent claims 1, 10, and 17 are anticipated by the Godfrey. Applicant disagrees that these cited sections of Godfrey, or any other part thereof, anticipates any Applicant's claims for at least the following reasons:

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<sup>1</sup> *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1349 (Fed. Cir. 1998); *Celeritas Techs. Ltd. v. Rockwell Intl. Corp.*, 150 F.3d 1354, 1360 (Fed. Cir. 1998).

<sup>2</sup> *Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc.*, 246 F.3d 1368, 1374 (Fed. Cir. 2001)(quoting *In re Donohue*, 766 F.2d 531, 533 (Fed. Cir. 1985).

(a) The cited sections are directed to receiving meeting requests, whereas Applicant's independent claims 1, 10 and 17 are directed to *selectively* transmitting an email attachment. At the outset, as set forth in the preamble of independent claims 1, 10 and 17, the cited sections of Godfrey fail to describe the limitation of both *selectively* transmitting and transmitting an email attachment. That is, Godfrey is directed to solving a calendaring problem, and Applicant's invention is directed toward limiting the proliferation of email attachments by allowing selective transmission of a received email. So, Godfrey and Applicant are solving disparate, non-overlapping problems. For these reasons, Applicant respectfully asserts that Godfrey fails to anticipate Applicant's independent claim 1, and by analogy, independent claims 10 and 17, as a matter of law.<sup>3</sup>

(b) Applicant's independent claim 1 first states, "receiving an instruction from a sender to add a selectable notification of an email attachment to a first email." This claim element and its limitations include, for example, an email client having the capability for a email sender to add a "selectable notification," such as coded instruction, to allow retrieval of an email attachment associated with the sender's first email through a second email that the sender sends to the recipient of the first email. Nowhere in the cited sections of Godfrey is this element and its limitations described at all.

In addition to the cited sections not describing Applicant's first claim element and its limitations, Applicant respectfully submits that the Office Action's statement of "note that accepting and declining the meeting request comprises the steps of selecting the notification" still fails to describe Applicant's first claim element and its limitations of "receiving an instruction from a sender to add a selectable notification of an email attachment to a first email." Instead, Applicant respectfully submits that the Office Action's statement focuses on accepting and declining something, which in Godfrey's case is a meeting request – not "receiving an instruction from a sender to add a selectable notification of an email attachment to a first email." For these reasons, Applicant respectfully asserts that Godfrey completely fails to describe Applicant's

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<sup>3</sup> *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1349 (Fed. Cir. 1998); *Celeritas Techs. Ltd. v. Rockwell Intl. Corp.*, 150 F.3d 1354, 1360 (Fed. Cir. 1998).

first element and its limitations, and, therefore, as a matter of law, Godfrey fails to anticipate Applicant's independent claim 1, and by analogy, independent claims 10 and 17.<sup>4</sup>

(c) Applicant's independent claim 1 then states, "inserting code in the first email to transmit a reply to the sender upon execution of the code by an email client, wherein execution is responsive to activation of the selectable notification by a recipient." Again, nowhere in the cited sections of Godfrey is this second element and its limitations described. That is, at the cited sections, there is no description of *inserting code, e.g., mark-up language or icon, in a first email to transmit a reply to the email sender when a selectable notification is executed* by the email recipient. There is no redirection in Applicant's invention. Applicant's claim 1 permits the email recipient to optionally receive an email attachment upon activation of selectable notification, *i.e.*, inserted code, found in a first email sent to and received by the email recipient. For these reasons, Applicant respectfully asserts that Godfrey also fails to describe Applicant's second element and its limitations, and, therefore, as a matter of law, Godfrey once again fails to anticipate Applicant's independent claim 1, and by analogy, independent claims 10 and 17.<sup>5</sup>

(d) Applicant's independent claim 1 next states, "generating a second email having the email attachment upon receipt of the reply." The cited sections again do not describe this third element and its limitations of generating a *second email with the email attachment upon receipt* by the email sender of a *reply* from the email recipient *occurring by the email recipient executing a selectable notification*. Dissimilar to Godfrey at the cited sections, Applicant's receipt of the email attachment, by the email recipient, is through a generated *second* email, wherein the email attachment is associated with the first email sent to the recipient. The email attachment may be received by the email recipient in a second email through activation of inserted code, *i.e.*, a selectable notification, inserted into the first email sent to the email recipient. For these reasons, and once again, Applicant respectfully asserts that Godfrey fails to

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<sup>4</sup> *Id.*

<sup>5</sup> *Id.*

describe Applicant's third element and its limitations, and, therefore, as a matter of law, Godfrey fails to anticipate Applicant's independent claim 1, and by analogy, independent claims 10 and 17.<sup>6</sup>

(e) Applicant's independent claim 1 finally states, "transmitting the second email to the recipient in response to the reply." At the cited sections, and in line with Applicant's argument *supra*, there is nothing in Godfrey that describes Applicant's *transmitting of any second email* in response to the *reply* as defined in Applicant's application. For these reasons, and once again, Applicant respectfully asserts that Godfrey fails to describe Applicant's fourth element and its limitations, and, therefore, as a matter of law, Godfrey fails to anticipate Applicant's independent claim 1, and by analogy, independent claims 10 and 17.<sup>7</sup>

(f) As shown in the foregoing remarks found in (a)-(e), since Applicant's independent claim 1 is not anticipated by Godfrey, and since the same foregoing remarks equally apply to Applicant's other independent claims 10 and 17, then any and all claims depending therefrom are also not anticipated.<sup>8</sup> Accordingly, and as a matter of law, Applicant respectfully requests that all § 102(e) rejections based on Godfrey be withdrawn as to claims 1-20.

5. Having now responded to all paragraphs of the Office Action, Applicant comments on the proposed, new claim 21. This new claim is supported by the specification and does not add any new matter. Accordingly, entry and allowance, in light of the foregoing, of new claim 21 is requested.

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<sup>6</sup> *Id.*

<sup>7</sup> *Id.*

<sup>8</sup> *In re Fine*, 837 F.2d 1071, 1076 (Fed. Cir. 1988)(if independent claim is allowable, then so are the dependent claims).

## CONCLUSION

Based on the foregoing argument and telephonic discussion with Examiner, Applicant respectfully submits that the instant application is in condition for allowance. Applicant invites the Office to freely reach Applicant's attorney using the contact information found in his signature block below.

Respectfully submitted,

Date: May 19, 2007

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